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REMARKS

The present application was originally filed with 7 Claims. In the Restriction Requirement mailed October 31, 2002, the Examiner restricted the Claims into two Groups, with Claims 1, 2-3, 4, 5-6 in Group I, and Claims 1, 4 and 7 in Group II. In a Response filed January 16, 2003, Applicants elected the Claims in Group I with traverse, and cancelled Claim 7. Applicants also elected the species "enzymes" as recited in Claim 6. Applicants respectfully submit that as the species originally elected are patentable, the remaining species are likewise allowable.

In the present Office Action, the Examiner rejected Claims 1-6 under 35 U.S.C. §102(b), as allegedly being anticipated by Bauer *et al.* (U.S. Patent No. 5,932,419). In regard to Claim 1, the Examiner argues that Bauer *et al.* describe a method for introducing site-directed mutations into circular DNA by means of mutagenic primer pairs. Applicants agree that Bauer *et al.* describe a method for introducing site-directed mutations into circular DNA by means of mutagenic primer pairs, but respectfully traverse the rejection and submit that this reference does not anticipate the presently claimed invention. As repeatedly indicated by the Courts, "[A]nticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention."² The Bauer *et al.* reference teaches the use of one primer pair, in which the primers are complementary (at least partially) to each other. Claim 1 has been amended to recite that the first and second oligonucleotides (*i.e.*, the primers) are non-complementary. Support for this provided in the Specification as filed (*See e.g.*, the Examples), and no new matter is added by this amendment. Applicants reserve the right to pursue the originally filed and/or broader Claims in subsequent filing(s). In addition, none of the amendments to the Claims is intended to narrow the scope of any of the amended Claims within the meaning of *Festo*³. Applicants also note that new Claim 8 has been added, which recites that multiple oligonucleotides are used. Support for this new Claim is provided throughout the Specification (*See e.g.*, the Examples). Thus, no new matter is added in this new Claim.

² *RCA Corp. v. applied Digital Data Sys., Inc.*, 730 F.2d 1440, 221 USPQ 385, 388 (Fed. Cir. 1984).

³ *Festo Corp. v. Shoketsu Kogyo Kabushiki Co.*, No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000).

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Unlike pending Claim 1, there is no teaching in the Bauer *et al.* reference that the primers be non-complementary. Indeed, the Bauer *et al.* reference repeatedly indicates that the primers are complementary or at least partially complementary (*See e.g.*, Bauer *et al.*, at col. 2, lines 44-50; col. 6, lines 46-48; and col. 6, lines 57-59). There is no teaching in Bauer *et al.* of the use of non-complementary primers. Applicants respectfully submit that as there is no teaching nor suggestion in the Bauer *et al.* reference that non-complementary primers be used, the Bauer *et al.* reference does not anticipate the presently claimed invention.

In addition, as Claim 1 is allowable over the prior art, the dependent Claims (Claims 2-6 and 8) are also allowable, as Bauer *et al.* do not teach nor suggest each and every element of these Claims. Thus, Applicants respectfully request that this rejection be withdrawn and the Claims passed to allowance.

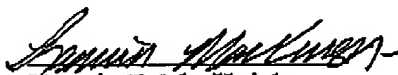
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CONCLUSION

In light of the above remarks, the Applicant believes that the pending claims are in condition for allowance and issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (650) 846-5838.

Respectfully submitted,

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